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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,179	06/25/2003	Michael A. Grillo		5209

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3676

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,179

Applicant(s)

GRILLO, MICHAEL A.

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 6, 13, 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/25/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings correction received on 10/13/04 (correction of reference numeral) is approved.
2. However, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "barrel bolt" and the "split bolt" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant Remarks indicate that Figures 1-3 illustrate the "barrel bolt" embodiment and the "split bolt" embodiments of the invention. While it is the examiner's position that neither of those embodiments of the invention are shown in the Figures, Applicant is reminded that, under 37 CFR 1.84(h)(5), the Figures must not show modified forms of construction in the same view. Corrected drawing sheets in compliance with 37 CFR 1.121(d) and/or clarification is required in reply to the Office action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 1-17, 19, and 20 are objected to because of the following informalities:

Recitation (claim 1) of "a mount attached to nonmovable structure on both sides of the movable structure" should be replaced with --"a mount attached to nonmovable structure on each side of the movable structure".

Recitation (claim 1 and 9) of "wherein the mount is conformed to,..." should be replaced with --each mount is conformed to,...--.

Recitation (claim 19) of "connecting a movable bolt receiver to the mount" should be replaced with --connecting a movable bolt receiver to each mount--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear what is meant by "barrel bolt" or "split bolt" or how the recited structure (assume-ably distinct from that which has been illustrated) affects function of invention whereby one of ordinary skill in the art could not make and use the claimed invention. Applicant argues that the "barrel bolt" and "split bolt" are shown but according to the written description, it seems these are separate embodiments. Assuming they are one embodiment as shown, it is not clear what structure makes it a *barrel* bolt in particular, or where the *split* is.

In that respect, it is not clear what is meant by the limitations. Accordingly, those same claims are rejected under 35 USC 112, second paragraph because it is not clear what is meant by the limitations "barrel bolt" or "split bolt" whereby the scope of the claimed invention cannot be reasonably determined.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 7-12, 14, 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,752,518 to Cannell.

Cannell '518 teaches Applicant's claim limitations including : a "plate" - 12, "with a rail" – the arcuate portion (as shown in Fig 3) of part 12, "attached to a movable structure" - 11, a "bolt movably attached to the rail" - 16, a "mount" - the door casing 17 and its openings 18, "attached to nonmovable structure" – the wall and its inherent framing.

As regards claim 2, 'as best understood', recitation of "barrel bolt" doesn't define over the barrel-shaped bolt of the reference.

As regards claim 3, the bolt 16 is "split" in left and right parts as shown in Fig 2 for example for engaging the two sides of the door frame.

As regards claim 5, opening 18 read on "movable bolt receiver" where no particular structure is defined that might be relied upon to patentably define from well known structure of the prior art which is disclosed to receive the "movable bolt". The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only

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necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it.

Kalman v. Kimberly-Clark Corp., 218 USPQ 789.

As regards claim 7, part 10 reads on limitation of "bolt carrier connected to the rail".

7. Claims 1-5, 7-12, 14, and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,340,172 to Sweet.

Sweet '172 teaches Applicant's claim limitations including : a "plate" – including 48,50a,50b, "with a rail" – including 44,46,47, "attached to a movable structure" – the double doors as shown in Fig 5 for example, a "bolt movably attached to the rail" - including 16,18,20a,20b, a "mount" – including 60a,60b, "attached to nonmovable structure" – the door jamb and/or wall and its inherent framing.

As regards claim 2, bolt portion 20a reads on limitation inasmuch as it has a barrel shape.

As regards claim 3, bolt portions 20a,20b are split by inclusion of part 16,18.

As regards claim 4, parts 60a,b are "adjustable", i.e., capable of being removed and placed further/closer to the plane of the door to accommodate different handle shank dimensions for example. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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As regards claim 5, part 66 receives "movable bolt" - 20a where no particular structure is defined in the claim that can be relied upon to patentably distinguish from well known structure of the prior art.

As regards claim 7, part 66 receives "movable bolt" - 20a where no particular structure is defined in the claim that can be relied upon to patentably distinguish from well known structure of the prior art where lack of dependency from claim 5 is noted. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974). Limitation of "connected" is broad enough to include intermediate elements.

Allowable Subject Matter

8. Claims 6, 13, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 10/13/04 have been fully considered but they are not persuasive.

Arguments that the drawings and written description fully disclose all claimed embodiments are not persuasive. The examiner agrees that a "bolt" (42) is shown, but written description implies that a "barrel bolt" is a different embodiment. It is not clear if the illustrated bolt (42) is a barrel bolt or if claim limitation of "barrel bolt" requires some

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additional structure that has not been illustrated. Similar consideration applies to claim limitation of "split bolt" where the written description implies that it is a different embodiment and to the contrary, indicates that it is illustrated. Where is the 'split' in the bolt? Applicant argues that a single bolt and a split bolt are shown. Does that mean the illustrated bolt is a single bolt and a split bolt at the same time. It is suggested that Applicant explain any specific structure that might be implied by recitations of "barrel bolt" and "split bolt" and amend the drawings and written description to include reference numerals to same. No new matter can be entered. If the limitations describe distinct embodiments, it is suggested that Figures and description specific to each embodiment be added. However, no new matter can be entered. In any case, it is required that Applicant address this issue as regards what physical structure is at least *intended* through the recitations since it is not clear what the scope of the claims include.

As regards rejection in view of Sweet '172, Examiner notes that claim 2 depends from claim 1 whereby any registered practitioner should know that claim 2 could only be anticipated if the limitations of its base claim 1 were anticipated. The Office action lists the limitations of base claim 1 and explains how those limitations were interpreted in reading the structure of the Sweet '172 reference on the claim. The typo in the preamble statement of rejection has been corrected. Otherwise, it's noted that any defects or errors in an Office action should be pointed out (see MPEP 710.06) timely to allow the Action to be corrected and re-mailed as appropriate. Additionally, Applicant is

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courteously invited to telephone interview at the number below if any part of an Office Action is not clear.

Arguments that parts 12 of Cannell '518 are attached to the movable structure are beside the point where the rejection states that door casing (17) reads on broad limitation of "mount. The test for (product claim) patentability is not whether the prior art's structure can be described using terminology different from the what has been disclosed as the invention but whether broadest reasonable interpretation of the claim language can be read on the structure of the prior art. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. It has been held that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). If prosecution is Continued, it is suggested that the structure of the disclosed 'mounts' be more specifically described in the claims. The same consideration applies to Applicant's arguments against rejection in view of the Sweet '172 reference where those arguments are admittedly "the same".

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

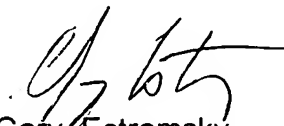
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
Art Unit 3676